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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,495	03/31/2004	Sung-Jin Kim	SJKIM-002USC	6449
7663	7590	10/19/2004	EXAMINER	
STETINA BRUNDA GARRED & BRUCKER			COE, SUSAN D	
75 ENTERPRISE, SUITE 250			ART UNIT	
ALISO VIEJO, CA 92656			PAPER NUMBER	

1654

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,495

Applicant(s)

KIM, SUNG-JIN

Examiner

Susan D. Coe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/27/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

1. The preliminary amendment filed March 31, 2004 has been received and entered.
2. Claims 1-15 are currently pending.

Claim Objections

3. Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot refer to more than one set of claims. Claim 11 is drawn to the composition of claim 1 made by the process described in claim 3. This is improper. See MPEP § 608.01(n).
4. Claim 11 is also because of the following informalities: there is an inappropriate paragraph break between “chloroform:” and “methanol” in lines 12 and 13. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 is indefinite because the phrase “protecting brain cells” is considered indefinite. The phrase is indefinite because it is unclear exactly what conditions are encompassed by this phrase because it is not clear what the brain cells are being protected from. Without a clear

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definition of what is considered to fall within the scope of this limitation, the metes and bounds of the claims are unclear.

6. Claim 3 is indefinite because it is not clear at what point this step fits into the extraction described in the claim 1.

7. Claim 11 is indefinite because it is drawn to the composition of claim 1 made by the process described in claim 3. This is confusing because it is unclear what limitations need to be met in order to practice the invention as claimed.

In addition, the claim states that the Asiasari extracts are obtained by the "method described in claims 3 [sic]." Claim 3 is drawn to a composition made by a process; however, since claim 3 is a composition claim, it is confusing to refer to it as a method claim.

Claim 11 is also indefinite because the phrase "among these" in line 12 is confusing. It is unclear what is being referred to by "these."

8. Claim 14 recites the limitation "said the content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 15 is indefinite because the claim uses improper Markush language. This improper Markush language makes it unclear what types of preparations are considered "oral preparations."

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claims 12-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 12-15 of prior U.S. Patent No. 6,737,087. This is a double patenting rejection.

The pending claims 12-15 are directed to the same invention as patented claims 12-15. There are two differences found between pending claim 12 and patented claim 12. Firstly, patented claim 12 states that the "lower alcohols" have 1 to 4 carbon atoms. The pending claim uses lower alcohols, but does not define what numbers of carbon atoms are encompassed by "lower." In order to define this phrase it is necessary to consult the specification. Page 9, paragraph 31, defines lower alcohols as alcohols containing 1 to 4 carbon atoms. Thus, the lower alcohols used in the pending claims have the same definition as that stated in the patented claims.

Secondly, patented claim 12 states that the composition intended to be used for protecting brain cells and improving memory. The pending claims only recite the intended use of improving memory. However, in composition claims, an intended use is only given patentable weight when it results in a structural difference between the pending composition and the previously disclosed composition. Clearly, the extraction procedure in the two sets of claims is the same. Thus, the two compositions are structurally identical. Therefore, because the two are identical, the intended use does not garner patentable weight and the scope of the two claims is identical.

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Claims 13-15 also correspond in subject matter and scope to claims 13-15 of the patent; thus, they are properly rejected under statutory double patenting.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,737,087. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims overlaps with the scope of the current claims. This overlap in scope is evidenced by the fact that both are drawn to *Asiasari radix* composition extracted using multiple pH extractions. The broadest claim of US '087, claim 1, contains more steps than the broadest pending claim, i.e. claim 1; however, the claim 1 of US '087 would anticipate pending claim 1. Thus, due to this significant overlap in scope, the current claims are properly rejected under obviousness-type double patenting.

12. No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

A handwritten signature in cursive script that reads "Susan D. Coe".

Susan D. Coe, Examiner

October 4, 2004